

Remarks

In view of the above amendments and the following remarks, reconsideration of the outstanding office action is respectfully requested.

The objection to claims 1 and 8-12 is traversed in view of the above amendments. With respect to the election of species requirement concerning the feature to be examined initially by the U.S. Patent and Trademark Office ("PTO"), applicants submit that because claims 1 and 8-12 are allowable for the reasons discussed below, the election of species requirement should be withdrawn and the claims examined fully.

The rejection of claims 1, 2, and 8-12 under 35 U.S.C. § 112 (first paragraph) for lack of enablement is respectfully traversed. The PTO has taken the position that the specification fails to enable formation of actin microspike upon transformation of a cell with a nucleic acid molecule encoding a biliverdin reductase as recited in claim 1. Applicant disagrees.

Applicant hereby submits a Second Declaration of Mahin D. Maines under 37 C.F.R. § 1.132 ("Second Maines Decl."). As demonstrated by the Second Maines Decl. at ¶¶ 4-10, the transformation of cells with BVR-encoding nucleic acid is sufficient to cause changes in cellular morphology, including formation of microspikes that are characterized by the presence of actin. On the basis of the description in the present application and the evidence provided by above-identified Second Maines Decl., it is apparent that the microspikes formed upon transformation with BVR-encoding nucleic acid are, indeed, formed of actin.

For these reasons, the rejection of claims 1 and 8-12 for lack of enablement is improper and should be withdrawn.

The rejection of claims 1, 2, and 8-12 under 35 U.S.C. § 112 (first paragraph) as lacking written descriptive support is respectfully traversed. This rejection is likewise premised upon the PTO's position that the specification fails to demonstrate that the microspikes formed upon transformation with BVR-encoding nucleic acid are, indeed, formed of actin. For the reasons noted above, the description in the application is confirmed by the Second Maines Decl. Therefore, the rejection of claims 1 and 8-12 is improper and should be withdrawn.

In view of all of the foregoing, applicant earnestly submits that this case is in condition for allowance.

Respectfully submitted,

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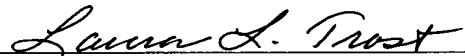
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February 17, 2005
Date


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